

Application No. 09/654,987
Page 9

Amendment
Attorney Docket No. S63.2B-8765-US01

REMARKS

This Amendment is in response to the Office Action dated May 5, 2003. In the Office Action claims 31-32, 34-37, and 47-49 were rejected under 35 U.S.C. 112, first paragraph. It was asserted by the Examiner that the original disclosure does not provide sufficient support to the following claim limitations: "*at least two lenses*"; "*at least two lens*"; "*striking at least one mirror*". The Office Action also rejected claims 31-33 and 35-37 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 39-44, 46-49, 51, and 55-60 were rejected under 35 U.S.C. 102(b) as being anticipated by Forman (US 5,501,759). Claims 39, 41-44, 46-51, and 55-60 were rejected under 35 U.S.C. 103(a) as being unpatentable over Forman (US 5,501,759) in view of Wysocki et al (US 5,339,380). Claims 40, 44-45, and 52-54 were rejected under 35 U.S.C. 103(a) as being unpatentable over Forman (US 5,501,759). Claims 52-54 were rejected under 35 U.S.C. 103(a) as being unpatentable over Forman (US 5,501,759) in view of Wysocki et al and further in view of Buchroeder et al (US 4,623,776). Claims 1-13, 16, and 38 are allowed. Applicant addresses these rejections under headings corresponding to the paragraph numbering of the Office Action.

2

In the Office Action claims 31-32, 34-37, and 47-49 were rejected under 35 U.S.C. 112, first paragraph. It was asserted by the Examiner that the original disclosure does not provide sufficient support to the following claim limitations: "*at least two lenses*"; "*at least two lens*"; "*striking at least one mirror*". Claims 34, 36, 37, and 47-49 have been amended to address this rejection. Claims 31-32 have been cancelled without prejudice or disclaimer.

4

In the Office Action claims 31-33 and 35-37 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 31-32 and 36-37 were said to be redundant. Claims 31-32 have been cancelled without prejudice or disclaimer to address the

Application No. 09/654,987
Page 10

Amendment
Attorney Docket No. S63.2B-8765-US01

rejection.

Claims 33 and 35 were said to appear to broaden claim 1 rather than narrowing it. Claims 33 and 35 have been cancelled without prejudice or disclaimer to address the rejection.

6

In the Office Action claims 39-44, 46-49, 51, and 55-60 were rejected under 35 U.S.C. 102(b) as being anticipated by Forman (US 5,501,759). The Office Action addresses a limitation not found in claim 39. The Office Action cites for claim 39 the language "generating at least one annular beam of electromagnetic energy substantially continuous in the annular direction, ..." This is the language used in a previous wording of claim 1. However, claim 39 of the RCE filed May 5, 2003 recites "generating a first beam of electromagnetic energy..."

In this Amendment claim 39 has been amended. Applicant emphasizes that Forman does not teach or disclose the combination of generating a first beam of substantially annular electromagnetic energy without impinging on the polymeric material or the polymeric catheter tube and then redirecting the beam such that it converges onto the polymeric material. To the extent, for the sake of argument, that Forman can be construed as disclosing an annular beam, the beam is not redirected. For this reason independent claim 39 and dependent claims 40-44, 46-49, and 51 dependent thereon are not anticipated by Forman.

As to claim 55, Forman does not teach or disclose the combination of generating an annular beam of electromagnetic energy such that the annular beam is disposed about the longitudinal axis of the polymeric catheter tube without impinging on the polymeric material or the polymeric catheter tube and controllably redirecting at least a portion of the annular beam of electromagnetic energy such that it converges onto the polymeric material at the over-lapped portion circumscribing at least a portion of the polymeric catheter tube to at least partially melt at least one material selected from the group consisting of the polymeric material and the polymeric catheter tube along at least a portion of the overlapped portion. For this reason, independent claim 55 and dependent claims 56-60 dependent thereon are not anticipated by Forman.

Applicant respectfully requests that the 102(b) rejection be withdrawn.

Application No. 09/654,987
Page 11

Amendment
Attorney Docket No. S63.2B-8765-US01

8

In the Office Action claims 39, 41-44, 46-51, and 55-60 were rejected under 35 U.S.C. 103(a) as being unpatentable over Forman (US 5,501,759) in view of Wysocki et al (US 5,339,380). The Office Action asserts that in the event that the claim 39 limitation "*generating at least one annular beam of electromagnetic energy substantially continuous in the annular direction*" defines over the teachings of Forman, Wysocki provides this limitation. Both claims 39 and 55 require that the annular beam generated will not impinge on the polymeric material or the polymeric catheter tube. Wysocki discloses expanding a beam with an expander. There is no disclosure that the expanded beam is annular. Moreover, the beam used in Wysocki apparently impinges upon the article to be heated before the beam is redirected. Even if there were motivation to make the proposed combination, the combination would not result in an annular beam being formed without the beam impinging on the catheter as recited in the claims. For these reasons, claims 39, 41-44, 46-51, and 55-60 are not unpatentable over Forman in view of Wysocki et al. Applicant respectfully requests that this rejection be withdrawn.

9

In the Office Action claims 40, 44-45, and 52-54 were rejected under 35 U.S.C. 103(a) as being unpatentable over Forman (US 5,501,759). Claims 39 and 52 have been amended and are believed to be in condition for allowance. There is no specific teaching in Forman of an annular beam continuous in the annular direction being redirected onto a polymeric material. Dependent claims 40, 44-45, and 53-54 are also believed to be in condition for allowance as they are dependent upon an allowable base claim. Applicant respectfully requests that the rejection be withdrawn.

10

In the Office Action claims 52-54 were rejected under 35 U.S.C. 103(a) as being unpatentable over Forman (US 5,501,759) in view of Wysocki et al and further in view of Buchroeder et al (US 4,623,776). Claim 52 has been amended to recite that each annular beam is directed without impinging on the polymeric material or the polymeric catheter tube.

Application No. 09/654,987
Page 12

Amendment
Attorney Docket No. S63.2B-8765-US01

Buchroeder et al teaches slicing a material. If Buchroeder et al were combined with Forman and Wysocki the resulting procedure would destroy the work piece of Forman. For this reason the combination is inappropriate.

In addition, for this rejection, a process involving the cutting of material in making contact lenses (Buchroeder et al) and a process for splicing optical cables (Wysocki) have been combined with Forman in rejecting the instant process of bonding at least two polymeric materials to a catheter tube. One would not look to all of these areas in order to bond a polymeric material to a catheter tube. Both Forman and Wysocki involve melting in order to bond materials together. It is incongruous to add the slicing art of Buchroeder et al to Forman and Wysocki. Not only are all three references dealing with very different materials being processed, the process in Buchroeder et al involves cutting rather than bonding. There is no suggestion, teaching, or motivation to combine these references or the processes in the references. The Federal Circuit stated that combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, which is the essence of hindsight. *In re Dembicza*k, 50 U.S.P.Q.2d 1614 (CAFC 1999). As Applicant believes this combination is inappropriate and would destroy the workpiece of Forman, Applicant respectfully requests that the rejection be withdrawn.

11

Applicant acknowledges the allowance of claims 1-13, 16, and 38.

Application No. 09/654,987
Page 13

Amendment
Attorney Docket No. S63.2B-8765-US01

CONCLUSION

In light of the above, early notification that pending claims 1-13, 16, 34, 36-60 are in condition for allowance is earnestly solicited.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: August 11, 2003

By: Brendan Babcock
Brendan Babcock
Registration No.: 50,705

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9131
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

OFFICIAL

FAX RECEIVED
AUG 13 2003
GROUP 1700